

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alexander Kurganov
Title: Personal Voice-Based Information
Retrieval System
Appl. No.: 09/777,406
Filing Date: 2/6/2001
Examiner: Kristie D. Shingles
Art Unit: 2141
Confirmation Number: 4531

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Applicant traverses the final rejection of claims 32-34 and 50-67 under 35 U.S.C. § 102(e) ("Section 102(e)") as being anticipated by U.S. Patent Application Publication No. 2001/0032234 to Summers et al. ("the *Summers* Application"). The *Summers* Application is not prior art with respect to the rejected claims of the present application. The *Summers* Application was filed after the present application. The parent applications to which the *Summers* Application claims priority do not disclose all of the elements of Applicant's claimed invention and, therefore, cannot form the basis for a Section 102(e) rejection. Accordingly, Applicant

respectfully requests that the final rejection under Section 102(e) based on the *Summers* Application be withdrawn.

I. New Matter In A Continuation-In-Part Application Is Not Entitled To An Earlier Priority Date

Subject matter disclosed for the first time in a continuation-in-part application that is not adequately supported by the parent application is entitled only to the filing date of the continuation-in-part application and cannot claim priority to the earlier-filed parent application. *In re Chu*, 66 F.3d 292, 297, 36 U.S.P.Q.2d 1089 (Fed. Cir. 1995) (“a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application”); *Transco Prods., Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 557, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994) (“an application is entitled to the benefit of the filing date of an earlier application as to common subject matter”); *In re Van Lagenhoven*, 458 F.2d 132, 136, 173 U.S.P.Q. 426 (C.C.P.A. 1972) (“subject matter which is first disclosed in a continuation-in-part application is not entitled to the filing date of the parent application”); MPEP § 201.11(I)(B) (“[a claim] which was first introduced or adequately supported in the continuation-in-part application . . . is entitled only to the filing date of the continuation-in-part application”); MPEP § 2133.01 (“When applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP.”).

Similarly, subject matter disclosed for the first time in a non-provisional application that is not supported by an earlier-filed provisional application is entitled only to the filing date of the non-provisional application. *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 U.S.P.Q.2d 1843 (Fed. Cir. 2002); MPEP § 201.11(I)(A) (“If a claim in the nonprovisional application is not adequately supported by the written description and drawing(s) (if any) of the provisional application . . . [the claim] is not entitled to the benefit of the filing date of the provisional application.”) (emphasis in original).

II. The Claimed Invention Is Not Disclosed In The Priority Applications

The *Summers* Application is a continuation-in-part of U.S. Patent Application No. 09/464,989 by *Wesemann* filed December 16, 1999 (“the *Wesemann* Application”) and is a non-provisional application of U.S. Provisional Patent Application No. 60/263,003 filed January 19, 2001 (“the ‘003 Provisional”). Therefore, any subject matter disclosed in the *Summers* Application that is not supported by either the *Wesemann* Application or the ‘003 Provisional is not entitled to a priority date prior to the May 11, 2001 filing date of the *Summers* Application, and cannot be considered as Section 102(e) prior art with respect to the present application. See MPEP § 201.11 and cases cited in Section I *supra*.

Independent claims 32, 53, and 63, as previously amended in response to the Office Action dated March 20, 2006, focus on the features of the preferred embodiment which allow finding the requested information from a pre-selected web site even if the information is moved from the pre-defined portion of the web site where the information was previously found. Specifically, independent claims 32, 53, and 63 were amended to include:

at least one instruction set stored on said server for identifying the pre-defined portion of the pre-selected web site and for identifying a named object associated with the content of the information to be retrieved, said pre-defined portion containing the information to be retrieved from the web site, each said instruction set comprising: a uniform resource locator address for said web site; a content descriptor of said web site, said content descriptor pre-defining the portion of said web site from which said information is to be retrieved, and the named object.

The ‘003 Provisional does not disclose “said instruction set comprising: a uniform resource locator address for said web site; a content descriptor of said web site, said content descriptor pre-defining the portion of said web site from which said information is to be retrieved, and the named object.” Rather, the system of the ‘003 Provisional searches HTML tags (or “pointers”) to locate certain information. ‘003 Provisional, p. 6. As a result, only information embedded in the HTML tags can be located. *Id.* Applicant’s content descriptor file,

on the other hand, includes other aspects of a webpage beyond HTML tags, which makes the present application more likely to locate information on a webpage that has been updated. Application, p. 21, ll. 12-16 (stating that any descriptions may be used, including HTML, WML, HDML, and XML); *see also* Table 1 (showing an example of a comprehensive content descriptor file).

Additionally, the *Wesemann* Application does not disclose “each said instruction set comprising: a uniform resource locator address for said web site; a content descriptor of said web site, said content descriptor pre-defining the portion of said web site from which said information is to be retrieved, and the named object.” Rather, the system of the *Wesemann* Application searches HTML tags (or “pointers”) to locate certain information. *Wesemann* Application, p. 17, ll. 9-13. As a result, only information embedded in the HTML tags can be located. *Id.* Applicant’s content descriptor file, on the other hand, includes other aspects of a webpage beyond HTML tags, which makes the present application more likely to locate information on a webpage that has been updated. Application, p. 21, ll. 12-16 (stating that any descriptions may be used, including HTML, WML, HDML, and XML); *see also* Table 1 (showing an example of a comprehensive content descriptor file).

III. The Summers Application Is Not Section 102(e) Prior Art

To the extent that the Examiner believes that the *Summers* Application discloses this claimed feature, any disclosure of such subject matter cannot claim a priority date prior to the May 11, 2001 filing date of the *Summers* Application, because the claimed feature is not disclosed in either the '003 Provisional or the *Wesemann* Application. As the May 11, 2001 filing date of the *Summers* Application is more than three months after the February 6, 2001 filing date of the present application, any disclosure of this claimed feature by the *Summers* Application is not prior art with respect to the present application.

Accordingly, Applicant respectfully requests that the final rejection be withdrawn and that claims 32, 34 and 50-68 be allowed to issue because the *Summers* Application, which was


filed after the present application, is not prior art and the parent applications to which the *Summers* Application claims priority—as necessary to support a Section 102(e) rejection—do not disclose all of the elements of Applicant’s claimed invention.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

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